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10/660,281	09/10/2003	Lance R. Peterson	0112300-1529	5293

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BELL, BOYD & LLOYD LLP  
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CHICAGO, IL 60690

EXAMINER
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SARKHILI, SARA

ART UNIT	PAPER NUMBER
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3714

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/03/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

10/660,281

Applicant(s)

PETERSON ET AL.

Examiner

Sara Sarkhili

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10 September 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☐ Claim(s) \_\_\_\_\_ is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-94 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date See Continuation Sheet.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

Continuation of Attachment(s) 3). Information Disclosure Statement(s) (PTO/SB/08), Paper No(s)/Mail Date :05/10/2004 and 01/13/2005 and 09/07/2006 .

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**Claims 1-3 and 7-24 are rejected under 35 U.S.C. 102(b) as being anticipated by Adams (US 5882261).**

As to Claim 1: Adams (US 5882261) discloses

A gaming device comprising a wheel with a plurality of digits on it, and a display device adapted to display said plurality of digits (Fig. 2);

a plurality of player-selectable digit positions displayed by the display device (Fig. 2);

and a processor operable with the display device to select and display a predetermined number of digits, wherein said number is greater than one, enable a player to select one of said digit positions for each of said selected digits, associate each said selected digit with the digit position selected by the player, and determine an award based on an order of the digits associated with the digit positions by the player (Col. 3 Lines 1-28)

As to Claim 2: Adams '261 discloses

A mechanical bonus payout indicator, which can be considered as a display device that also has digits displayed on it (Col. 1 Lines 50-60 and Col.4 Lines 31-35).

As to Claim 3, Adams '261 discloses  
the mechanical indicator which can be also considered as the mechanical device and as  
shown is in a circular form (Fig. 2).

As to Claim 7, Adams '261 discloses:  
that the award could have a value of the order of the digits in the digit indicator (Col.2  
Lines 1-10). Adams explains a variety of determining how to make the payout (or  
award), among which includes awarding in the order of the digit displayed on the  
indicator.

As to Claim 8, Adams '261 discloses:  
that the award is based on a mathematical operation such as multiplication, which can  
include any digit in the indicator (Col.2 Lines 1-10).

As to Claim 9, Adams'261 discloses:  
a process that is operable to enable the player to have the freedom of choosing the  
order of indicia shown on the game (Col.2 Lines 1-12).

As to Claim 10, Adams'261 discloses:  
a player-selectable modified input, wherein activation of the modified input initiates an  
award modification method (Col.1 Line 51 – Col.2 Line 9).

As to Claim 11, Adams'261 discloses:

a process in which selection of one of the award modification methods is made to be applied to the award (Col.2 Lines 1-9).

As to Claim 12, Adams'261 discloses:

an award modification technique that includes multiplication with the digits shown by an indicator, and also addition or subtraction of the indicator (Col.2 Lines 1-26).

As to Claim 13, Adams'261 discloses:

a gaming device comprising: a display device (Fig. 1); a plurality of symbols adapted to be displayed by the display device, wherein said symbols include a plurality of digits and at least one selection symbol (Col.1 Lines 24-38);

a plurality of selections adapted to be displayed by the display device, wherein one of a plurality of the digits is associated with each selection; a plurality of digit positions displayed by the display device (Col.1 Lines 24-38); and a processor operable with the display device to:

- (a) pick a predetermined number of symbols (Col.1 Lines 24-38);
- (b) enable a player to associate each of said symbols with one of said digit positions (Col.1 Lines 24-38);
- (c) enable the player to pick one of said plurality of selections if the selection symbol is picked (Col.1 Lines 24-38);

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- (d) associate the digit associated with the selection picked by the player with the digit position with which the selection symbol is associated if the selection symbol is picked (Col.1 Lines 24-38); and
- (e) determine an award based on an order of digits associated with the digit positions (Col.3 Line 66- Col. 4 Line 6).

As to Claim 14, Adams'261 discloses:

that the displayed digits and the selection symbol are displayed on a mechanical display device (or indicator)(Col.6 Lines 3-8).

As to claim 15, Adams'261 discloses:

a mechanical display device that is substantially circular (Claim 23).

As to claim 16, Adams'261 discloses:

That the display device reveals to the player the digit associated with the selection symbol if the selection symbol is picked (Claim 27).

As to claim 17, Adams'261 discloses:

that the number of digit positions is predetermined (Claim 27).

As to claim 18, Adams'261 discloses:

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That the player pushes a button, when the primary reels indicate one of a predetermined plurality of indicia, which is similar to the player being enabled to pick a digit position before said digit is randomly picked (Col.2 Lines 10-14).

As to Claim 19, Adams'261 discloses:

An award that is based on an order of the digits in said digit positions (Col.2 Lines 27-41).

As to Claim 20, Adams'261 discloses:

an award that is based on combining by a mathematical operation at least two of said digits in said digit positions (Col.2 Lines 1-8).

As to Claim 21, Adams'261 discloses:

A processor that is operable to enable the player to rearrange the order of the digits or his selection as he chooses (Col.2 Lines 1-13).

As to Claim 22, Adams'261 discloses:

The gaming device selectable modify input, wherein award modification method includes a player-activation of the modify input initiates an award modification method (Col.2 Lines 13-26).

As to Claim 23, Adams discloses:



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award modification methods that includes performing different mathematical operation on the award, regenerating an award, etc. (Col. 2 Lines 1-51)

As to Claim 24, Adams'261 discloses:

an award modification method, and wherein the processor randomly determines if an award modification method will be applied to the award (Col. 1 Lines 24-38 and Col. 2 Lines 22-26).

**Claims 1, 4, 6 and 25-33 and 35-59 and 62-94 are rejected under 35 U.S.C. 102(b) as being anticipated by Adams (U.S. 5823874)**

As to Claim 1: Adams'874 discloses:

A gaming device comprising a wheel with a plurality of digits on it, and a display device adapted to display said plurality of digits (Fig. 2);  
a plurality of player-selectable digit positions displayed by the display device (Fig. 2);  
and a processor operable with the display device to select and display a predetermined number of digits, wherein said number is greater than one, enable a player to select one of said digit positions for each of said selected digits, associate each said selected digit with the digit position selected by the player, and determine an award based on an order of the digits associated with the digit positions by the player (Col.1 Line 52 - Col. 2 Line 9)

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As to Claim 4, Adams '874 discloses:

that the number of player-selectable indicia positions is predetermined (Col.2 Lines 1-61).

As to Claim 6, Adams '874 discloses:

that the game enables the player to make a selection of different kinds (Col.1 Lines 21-34). Among these selections, one can include enabling the player to select digits in different formats.

As to Claim 25, Adams '874 discloses:

a gaming device comprising: a plurality of digits; a mechanical display device adapted to display said plurality of digits; a plurality of selectable digit positions (Abstract); and an award adapted to be provided to a player including a plurality of digits associated with the digit positions by the player, wherein the order of said digits indicates a value of the award (Col. 1 Line 52- Col. 2 Line10)

As to Claim 26, Adams '874 discloses:

a mechanical display device (or a wheel indicator) that includes a plurality of sections, wherein one of the plurality of digits is displayed in each section (Col.1 Lines 52-67 and Fig.2).

As to Claim 27, Adams '874 discloses:

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that the mechanical display device is substantially circular (Col. 1 Lines 52-67 and Fig. 2).

As to Claim 28, Adams '874 discloses:

that the mechanical display device is adapted to rotate and stop at a position wherein an indicator indicates one of the plurality of digits (Col. 3 Lines 5-25).

As to Claim 29, Adams '874 discloses:

a selection symbol displayed by the mechanical display device, said selection symbol indicating a selection of at least one of a plurality of selections, wherein one of the plurality of digits is associated with each selection (Col. 1 Lines 20-35).

As to Claim 30, Adams '874 discloses:

that the plurality of selections are displayed by a mechanical display device (Col. 2 Lines 30-49).

As to Claim 31, Adams '874 discloses:

a game; a cabinet; a moveable mechanical display device supported by the cabinet and having a plurality of modification methods displayed thereon (Col. 4 Lines 46-59), wherein the mechanical display device is operable to simultaneously display a plurality of the modification methods to a player (Fig. 1);  
an indicator supported by the cabinet and operable to move to indicate one of the modification methods which is displayed when the mechanical display device stops

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moving (Abstract and Col.1 Lines 52-65);

an original award including a plurality of digits associated with a plurality of digit positions, wherein the order of said digits indicates a value of the original award (Col.1 Lines 52-65); and

a modified award including a modification of the digits of the original award based on the modification method indicated by the indicator and mechanical display device (Col. 1 Line 66 – Col.2 Line9).

As to Claim 32, Adams '874 discloses:

that each modification method is associated with one of a plurality of sections of the mechanical display device (Col. 1 Line 66 – Col.2 Line9).

As to Claim 33, Adams '874 discloses:

That the mechanical display device includes a plurality of surfaces, each said surface displaying at least one of the modification methods (Fig. 2).

As to Claim 36, Adams '874 discloses:

that the mechanical display device is positioned on a longitudinally extending rotational axis (Fig. 1).

As to Claim 37, Adams '874 discloses:

that the indicator is operable to move substantially parallel to the longitudinal rotational axis (Fig. 1).

As to Claim 38, Adams '874 discloses:

that the mechanical display device is adapted to rotate along a rotational axis and to stop to reveal at least one modification method (Col.3 Lines 5-24).

As to Claim 39, Adams '874 discloses:

that rotational axis is substantially horizontally disposed (Fig. 1).

As to Claim 40, Adams '874 discloses:

means for oscillating the indicator relative to the mechanical display device (Fig. 1 and Col.3 Lines 5-24).

As to Claim 41, Adams '874 discloses:

that the oscillation of the indicator is substantially parallel to the rotational axis of the mechanical display (Fig. 1 and Col.3 Lines 5-24).

As to Claim 42, Adams '874 discloses:

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that the movement of the indicator is coordinated with the movement of the mechanical display device to designate one of the award modification methods to be applied to the award (Fig. 1 and Col.3 Lines 5-24).

As to Claim 43, Adams '874 discloses:

the indicator moves simultaneously with the movement of the mechanical display device (Fig. 2).

As to Claim 44, Adams '874 discloses:

A mechanism that controls the movement of the mechanical display and the movement of the indicator (Col.2, Lines 10-15).

As to Claim 45, Adams '874 discloses:

a predetermined sequence that causes the mechanical display and the indicator to move simultaneously (Col.1 Lines 52-65).

As to Claim 46, Adams '874 discloses:

a possible predetermined sequence that could cause the indicator to move after the mechanical display stops rotating (Col.1 Lines 52-65).

As to Claim 47, Adams '874 discloses:

a predetermined sequence that causes the indicator to pass by each of the modification

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methods of the modification methods at least once before stopping to indicate one of the displayed modification methods (Col.1 Lines 52-65).

As to Claim 48, Adams '874 discloses:

that the movement of the mechanical display and the movement of the indicator are controlled by a random generation (Col.1 Lines 21-35 and Col.2 Lines 10-15).

As to Claim 49, Adams '874 discloses:

that the movement of the mechanical display and the movement of the indicator are individually controlled by separate random generations (Col.1 Lines 21-35 and Col.2 Lines 10-15).

As to Claim 50, Adams '874 discloses:

a gaming device comprising:

a plurality of digits (Fig. 1)

Mechanical display device adapted to display said plurality of

a plurality of selectable digit positions (Fig. 1); an original award determined based on a plurality of digits associated with the digit positions, wherein the order of said digits indicates a value of the original award (Col. 1 Line 66 – Col.2 Line 10);

a plurality of different award modification methods (Col. 1 Line 66 – Col.2 Line 10);

a second mechanical display device adapted to display said award modification methods (Col.3 Lines 24-43); and

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a modified award determined based on a modification of the digits of the original award by the modification method indicated by the second mechanical display device (Col.3 Lines 24-43).

As to Claim 51, Adams '874 discloses:

that the modified digits of the original award and the digits of the original award indicate an amount of the modified award (Col.3 Lines 24-43).

As to Claim 52, Adams '874 discloses:

that a selectable modify input which controls the processor is activated to initiate one of the award modification methods selected from the plurality of modification methods (Col. 1 Line 66 – Col.2 Line 10).

As to Claim 53, Adams '874 discloses:

a processor which controls the mechanical display device and which is operable to randomly select a predetermined number of digits, enable a player to select one of said digit positions after each of said digits is selected, and associate said digit with the digit position selected by the player (Col.1 Lines 21-35 and Col.2 Lines 10-15).

As to Claim 54, Adams '874 discloses:

an original award including a plurality of digits displayed by the display device, said original award resulting from a player selecting one of said digit positions after each of



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said digits is randomly selected, wherein the order of said digits indicates an amount of the original award (Col.3 Lines 24-43).

As to Claim 55, Adams '874 discloses:

that upon a triggering event in the game, said processor enables the player to select one of a plurality of digits associated with each of a plurality of selections, and to associate said digit with one of said digit positions (Col.2 Lines 30-48).

As to Claim 56, Adams '874 discloses:

that the triggering event includes the selection of a selection symbol displayed on the first mechanical display (Col.2 Lines 30-48).

As to Claim 57, Adams '874 discloses:

that the digit associated with the selection is revealed if the selection is selected (Col.2 Lines 30-48).

As to Claim 58, Adams '874 discloses:

that the plurality of digits are displayed on a first mechanical display device, said first mechanical display device is substantially circular (Col.2 Lines 30-48).

As to Claim 59, Adams '874 discloses:

that the award modification methods are displayed by a second mechanical display device (Col.1 Lines 52-65).

As to Claim 62, Adams '874 discloses:

that the movement of a translating indicator is coordinated with the rotation of the second mechanical display device to designate one of the award modification methods to be applied to the award (Col.5 Line 58- Col. 6 Line 11).

As to Claims 63-80, Adams '874 discloses:

that the award modification method that includes a rearrangement of the digits of the original award, and the ability to change the primary award won by the game. Adams '874 discloses several different methods that includes award modification techniques (Col. 1 Line 66 – Col.2 Line 10).

As to Claims 81, Adams '874 discloses:

A gaming device comprising: a plurality of digits; a display device adapted to display said plurality of digits;

a plurality of player-selectable digit positions displayed by the display device (Fig. 1 and 2); and

a processor operable with the display device to

(a) enable a player to select an order of a plurality of digit positions (Col. 1 Line 66 –

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Col.2 Line 10);

(b) select and display a predetermined number of digits, wherein said number is greater than one (Col. 1 Line 66 – Col.2 Line 10);,

(c) associate each of the selected digits with the digit positions related to the order selected by the player, and

(d) determine an award to provide to the player based on the order of the digits associated with the digit positions (Col.3 Lines 24-43).

As to Claims 82-83, Adams '874 discloses:

that the order of the digits associated with the digit positions is based on the order of the plurality of digit positions selected by the player and the order in which the predetermined number of digits is selected and displayed (Col.2 Lines 30-48). Adams '874 describes a general format of selection by the player and payout which includes the above method as well.

As to Claim 84, Adams '874 discloses:

that the display device includes a mechanical display of the digits (Col. 1 Lines 52-65)

As to Claim 85, Adams '874 discloses:

that the mechanical display is substantially circular (Fig. 1 and 2).

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As to Claim 86, Adams '874 discloses:

that the number of player-selectable digit positions is predetermined (abstract and Col. 1 Lines 52-65).

As to Claim 87, Adams '874 discloses:

that the digit positions include a one's digit position, a ten's digit position and a hundred's digit position (Fig. 2 Item 110).

As to Claim 88, Adams '874 discloses:

that the player has the freedom to push any button or select any indicia or digit. That indicates that the processor is operable to enable the player to select a digit position for each digit before said digit is selected (Col.2 Lines 3048)

As to Claim 89, Adams '874 discloses:

that the award has a value of the order of the digits in said digit positions (abstract and Col. 1 Lines 52-65). Adams '874 specifically indicates that the award is determined by the values determined by the pointer, which would mean that the award would have a value of the order of the digits determined by the indicator.

As to Claim 90, Adams '874 discloses:

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A multiplier (a mathematical operation) that has the ability to change the award in different formats, which can also include a mathematical operation, applied to at least two of said digits in said digit positions (Col.1 Line 66 – Col.2 Line 9).

As to Claim 91, Adams '874 discloses:

that the processor is operable to enable the player to rearrange the order of the digits associated with the digit positions at least once (Col.1 Line 66 – Col.2 Line 9).

As to Claim 92 and 94, Adams '874 discloses:

a player-selectable modified input, wherein activation of the modified input initiates an award modification method (Col.1 Line 66 – Col.2 Line 9). Modification by the multiplier includes an input modification, which leads to a modification in the payout (award).

Adams '874 discloses a modification technique using a multiplier, which can include any of the modification described here.

As to Claim 93, Adams '874 discloses:

a processor that selects one of a plurality of award modification methods to apply to the award (Col. 2 Lines 30-48), by selecting a combination of indicia.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 34-35 and 60-61 are rejected under 35 U.S.C. 103(a) as being unpatentable over Adams '874.**

Adams'874 teaches all the elements in Claims 34-35 and 60-61 except that it does not expressly disclose the using of a prism shaped display device.

As to Claim 34, Adams '874 discloses:

34. The gaming device of Claim 31, wherein the mechanical display device is prism-shaped having three sides.

At the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to chose a prism shaped display device with displaying the modified method on each side of it, because Applicant has not disclosed that choosing a prism shaped display device provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Adams '874 display device, and applicant's invention, to perform equally well with either the current display device taught by Adams '874 or the claimed prism shaped display device because both display devices would perform the same function of displaying the outcome of the game and modified methods equally well.

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Therefore, it would have been prima facie obvious to modify Adams '874 to obtain the invention as specified in claims 34-35 and 60-61 because such a modification would have been considered a mere design consideration which fails to patentably distinguish over the prior art of Adams '874.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sara Sarkhili whose telephone number is 571-272-2831. The examiner can normally be reached on Mon-Fri 9-6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Xuan Thai can be reached on (571)272-7147. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

SS

Ronald Jensen  
Primary Examiner  
3/30/07

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